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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/754,522

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Jose Miguel Menendez

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EPSTEIN & GERKEN
1901 RESEARCH BOULEVARD
SUITE 340
ROCKVILLE, MD 20850

EXAMINER

SAFAVI, MICHAEL

ART UNIT

PAPER NUMBER

3673

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/754,522		MENENDEZ, JOSE MIGUEL	
	Examiner		Art Unit	
	Michael Safavi		3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004 & 19 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,8,16-26,30 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7,9-15,27-29 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National/Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>22 July 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of the SPECIES of Fig. 23 in the reply filed on 19 July 2006 is acknowledged.

Claims 5, 6, 8, 16-26, 30, and 32 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 19 July 2006.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 22 July 2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Specification

The disclosure is objected to because of the following informalities:

- (1) page 2, line 2 of paragraph no. [0001], after "2001," the words --now U.S. Patent No. 6,698,155, issued March 2, 2004,-- should be inserted; and
- (2) page 2, line 4 of paragraph no. [0001], after "1999," the words --now abandoned,-- should be inserted

Appropriate correction is required.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7, lines 1-3, the recitation that "said tips terminate at side edges and said planar portions respectively extend from said outer corners to said side edges" is vague, indefinite, and confusing because the planar portions of the side flanges (918, 920) actually terminate at the outside corners (923, 925) and NOT as the side edges (928, 930) of the tips (929, 931).

Claim 31, lines 1-2, the recitation of "said tips" is vague, indefinite, and confusing as lacking antecedent basis since no "tips" have been introduced in claim 27 on which claim 31 depends.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 7, 9-11, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by KAMM (U.S. Patent No. 5,592,786).

As to claim 1, KAMM discloses a building element (12 in Fig. 1) comprising:

a profile (12) extending lengthwise between first and second ends (28, 30) said profile (12) having a substantially uniform cross-section defined by a web (20), a pair of side flanges (16, 22) extending perpendicular to said web (20), and outer corners respectively joining said side flanges (16, 22) to said web (20), said web (20) having a constriction (32), a pair of planar segments (portions of 20 above and below 32) respectively disposed on opposite sides of said constriction (32), and inner corners respectively joining said planar segments (portions of 20 above and below 32) to said constriction (32), said constriction (32) including a pair of arms (34, 36) extending angularly inwardly from said inner corners, respectively, to a curved base (between 34 and 36) having an apex contained in a plane, said planar segments (portions of 20 above and below 32) having outer surfaces, respectively, contained in a plane parallel to said plane of said apex, said side flanges (16, 22) respectively extending from said outer corners in the same direction as said constriction (32) to tips (18, 24), respectively, contained in a plane parallel to said plane of said apex, said building element (12) having an overall width between said plane of said planar segments (portions of 20 above and below 32) and said plane of said tips (18, 24), said constriction (32) having a width between said plane of said planar segments (portions of

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20 above and below 32) and said plane of said apex about one-third said overall width (in Fig. 3, 32 appears to have a width which is “*about*” one-third the overall width of 12).

As to claim 2, KAMM discloses the building element (12) of claim 1 as discussed above, and KAMM also discloses that said side flanges (16, 22) include planar portions, respectively, having outer surfaces contained in parallel planes perpendicular to said plane of said planar segments (portions of 20 above and below 32), and said building element (12) has an overall height between said planes of said planar portions.

As to claim 3, KAMM discloses the building element (12) of claim 2 as discussed above, and KAMM also discloses that said constriction (32) is bisected by a constriction axis perpendicular to said plane of said planar segments (portions of 20 above and below 32) and said constriction axis is centrally located along said overall height of said building element (12).

As to claim 4, KAMM discloses the building element (12) of claim 3 as discussed above, and KAMM also discloses that said overall width is about one-half said overall height (in Fig. 3, it appears that the overall width is “*about*” one-half the overall height).

As to claim 7 (and as best understood despite the 35 U.S.C. 112, second paragraph, indefiniteness discussed above), KAMM discloses the building element (12) of claim 2 as discussed above, and KAMM also discloses that said tips (18, 24) terminate at side edges on one side and at a second outer corner on the other side and

said planar portions (16, 22) respectively extend from said outer corners to said second outer corner.

As to claim 9, KAMM discloses the building element (12) of claim 2 as discussed above, and KAMM also discloses that said planar portions (16, 22) respectively extend from said outer corners to said tips (18, 24) and said tips (18, 24) include end flanges (18, 24) extending from said planar portions (16, 22), respectively, inwardly toward one another.

As to claim 10, KAMM discloses the building element (12) of claim 9 as discussed above, and KAMM also discloses that said end flanges (18, 24) extend linearly from said planar portions (16, 22), respectively, perpendicular to said planar portions (16, 22) and parallel to said planar segments (portions of 20 above and below 32).

As to claim 11, KAMM discloses the building element (12) of claim 10 as discussed above, and KAMM also discloses that said planar portions (16, 22) are joined to said end flanges (18, 24) by curved outside corners, respectively.

As to claim 14, KAMM discloses the building element (12) of claim 1 as discussed above, and KAMM also discloses that said arms (34,36) are joined to said inner corners at junctions, respectively, and said constriction (32) has a height between said junctions no greater than one-fourth said overall height (in Fig. 3, 32 appears to have a height which is "*no greater than*" one-fourth the overall width of 12).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 13, 15, 27-29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over KAMM (U.S. Patent No. 5,592,786).

As to claim 12, KAMM discloses the building element (12) of claim 1 as discussed above, and KAMM also discloses that said arms (34, 36) extend linearly from said inner corners to said base.

KAMM fails to explicitly disclose that the arms define an included angle of about 70 degrees.

However, it is well settled that changes in size/proportion (i.e., dimensions) do not constitute a patentable difference. See *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference

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between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Therefore, it would have been an obvious expedient to one of ordinary skill in the art at the time the invention was made to modify the building element of KAMM by making the included angle between the arms of the constriction be about 70 degrees in order to form an optimum angle of the strengthening rib sidewalls along the webbing of the channel member and also because changes in size/proportion (i.e., dimensions) do not constitute a patentable difference.

As to claim 13, KAMM discloses the building element (12) of claim 12 as discussed above, and KAMM also discloses that said inner corners are curved and said outer corners are curved.

As to claim 15, KAMM discloses the building element (12) of claim 14 as discussed above.

KAMM fails to explicitly disclose that said constriction has a height of about 4.2 cm.

However, it is well settled that changes in size/proportion (i.e., dimensions) do not constitute a patentable difference. See *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package “of appreciable size and weight requiring handling by a lift truck” where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the

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package were not sufficient to patentably distinguish over the prior art.); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Therefore, it would have been an obvious expedient to one of ordinary skill in the art at the time the invention was made to modify the building element of KAMM by making the constriction have a height of about 4.2 cm in order for the height of the constriction to be commensurate with the desired included angle of the constriction, depending upon the size of the channel, and also because changes in size/proportion (i.e., dimensions) do not constitute a patentable difference.

As to claim 27, KAMM discloses a building element (12) comprising:

a profile (12) extending lengthwise between first and second ends (28, 30), said profile (12) having a substantially uniform cross-section defined by a web (20), a pair of side flanges (16, 22) extending perpendicular to said web (20), and outer corners respectively joining said side flanges (16, 22) to said web (20), said web (20) having a constriction (32) bisected by a constriction axis parallel to said side flanges (16, 22), a

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pair of web segments (portions of 20 above and below 32) respectively disposed on opposite sides of said constriction (32), and inner corners respectively joining said web segments (portions of 20 above and below 32) to said constriction (32), said constriction (32) including a pair of arms (34, 36) extending linearly and angularly inwardly from said inner corners, respectively, to a curved base (between 34 and 36).

KAMM fails to explicitly disclose that each of said arms define an angle of about 35° with said constriction axis.

However, it is well settled that changes in size/proportion (i.e., dimensions) do not constitute a patentable difference. See *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package “of appreciable size and weight requiring handling by a lift truck” where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) (“mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled.” 531 F.2d at 1053, 189 USPQ at 148.). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Therefore, it would have been an obvious expedient to one of ordinary skill in the art at the time the invention was made to modify the building element of KAMM by making each of the arms of the constriction define an angle of about 35° with the constriction axis in order to form an optimum angle of the strengthening rib sidewalls along the webbing of the channel member and also because changes in size/proportion (i.e., dimensions) do not constitute a patentable difference.

As to claim 28, KAMM discloses the building element (12) of claim 27 as discussed above, and KAMM also discloses that said web segments (portions of 20 above and below 32) are planar

As to claim 29, KAMM discloses the building element (12) of claim 27 as discussed above, and KAMM also discloses that said constriction axis is centrally located between said side flanges (16, 22).

As to claim 31 (and as best understood despite the 35 U.S.C. 112, second paragraph, indefiniteness discussed above), KAMM discloses the building element (12) of claim 27 as discussed above, and KAMM also discloses that said tips (18, 24) include end flanges (18, 24) angled (at 90 degrees) from said side flanges (16, 22), respectively.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,696,155 in view of KAMM (U.S. Patent No. 5,592,786).

Claim 1 of U.S. Patent	Claim 1 of U.S. Patent No.
Application Serial No. 10/754,522	6,698,155 discloses a building element
discloses a building element	for use as a column or beam,
comprising:	comprising:
a profile extending lengthwise	a profile extending lengthwise
between first and second ends,	between first and second ends,
said profile having a substantially	said profile having a substantially
uniform cross-section defined by a web,	uniform cross-section defined by a web,
a pair of side flanges extending	a pair of side flanges extending
perpendicular to said web, and	perpendicular to said web, and

outer corners respectively joining
said side flanges to said web,
said web having a constriction,
a pair of planar segments
respectively disposed on opposite sides
of said constriction, and

inner corners respectively joining
said planar segments to said
constriction,

said constriction including a pair
of arms extending angularly inwardly
from said inner corners, respectively, to
a curved base having an apex contained
in a plane,

said planar segments having
outer surfaces, respectively, contained
in a plane parallel to said plane of said
apex,

said side flanges respectively
extending from said outer corners in the
same direction as said constriction to
tips, respectively,

curved outer corners joining said
side flanges to said web, respectively
said web having a constriction,
a pair of planar segments
disposed on opposite sides of said
constriction, respectively, and

curved inner corners joining said
planar segments, respectively, to said
constriction,

said constriction extending from
said inner corners to a curved base
having an apex contained in a plane,

said planar segments having
outer surfaces, respectively, contained
in a plane parallel to said plane of said
apex,

said side flanges extending from
said outer corners, respectively, in the
same direction as said constriction to
terminate at side edges, respectively,

	<u>said apex being centrally disposed</u>
	<u>between said side flanges, said side</u>
contained in a plane parallel to said	<u>edges being</u> contained in a plane
plane of said apex,	parallel to said plane of said apex,
said building element having an	said building element having an
overall width between said plane of said	overall width between said plane of said
planar segments and said plane of said	planar segments and said plane of said
<u>tips,</u>	<u>side edges,</u>
said constriction having a width	said constriction having a width
between said plane of said planar	between said plane of said planar
segments and said plane of said apex	segments and said plane of said apex
about one-third said overall width.	about 1/3 said overall width.

Claim 1 of U.S. Patent No. 6,698,155 fails to explicitly disclose tips at the ends of the side edges.

KAMM discloses tips at the end of the side edges.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the building element of Claim 1 of U.S. Patent No. 6,698,155 by including tips at the ends of the side edges as taught by KAMM in order to enhance the torsional stability of the building element.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Various configurations of building elements are disclosed in: U.S. Patent No. 6,381,916 to Maisch et al.; U.S. Patent Application Publication No. 2006/0191227 (see Fig. 1); and U.S. Patent No. 6,802,170 to Davis.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Safavi whose telephone number is (571)-272-7046. The examiner can normally be reached on Monday through Thursday, 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia L. Engle can be reached on (571)-272-6660. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Safavi, Primary Examiner
October 2, 2006



**MICHAEL SAFAVI
PRIMARY EXAMINER
ART UNIT 354**